

REMARKS

Claim rejections under 35 USC 102

Claims 1-3, 9-11, 13-14, and 16-20 have been rejected under 35 USC 102(e) as being anticipated by Matsubayashi (6,938,202). Claims 1, 9, and 13 are independent claims, from which the remaining claims rejected on this basis ultimately depend. Applicant submits that as originally presented and as amended, claims 1, 9, and 13 are patentable over Matsubayashi, such that all the claims rejected on this basis are patentable at least because they depend from a patentable base independent claim. Insofar as the present rejection is concerned, Applicant discusses claim 1 as representative of all the independent claims.

It is noted that, under 35 USC 102, every limitation of a claim must *identically* appear in a single prior art reference for it to anticipate the claim. (In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990)) That is, the standard for anticipation under 35 USC 102 is that "[t]here must be *no difference* between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." (Scripps Clinic & Research Found. v. Genentech, Inc., 18 USPQ2d 1001, 1010 (Fed. Cir. 1991)) The prior art reference must disclose each element of the claimed invention "*arranged as in the claim*" in question. (Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984))

Applicant now discusses in detail two particular limitations of the claimed invention that are not found identically in Matsubayashi and/or that are not arranged in Matsubayashi as in claimed invention, such that there is a difference between the claimed invention and Matsubayashi.

Particular manner within which the link is displayed

With respect to displaying the link within the dialog box, the Examiner has indicated that how Matsubayashi operates is that the user enters the URL address of an embedded web server of a printer into an input area of a web browser. (See, e.g., office action, p. 4, “the request is preferably provoked by entry of a URL corresponding to server 32 into a browser application executing on a user’s computing system”; see also, e.g., id., p. 2, “displaying a dialog box (printer web page 55 . . .) to a user in response to a user input (input area 56 for entering a URL . . .)”) Thus, as noted by the Examiner, in Matsubayashi the user opens a web browser window, and then enters the URL address of the web server of the printer into the input area of the window. Applicant submits that *as amended*, however, the claimed invention is not anticipated by Matsubayashi in this respect.

In particular, Applicant has amended the claim invention so that “the link is displayed within the dialog box *without the user having to input the link*,” and such that “the link is *automatically* displayed within the dialog box as part of the dialog box being displayed.” Applicant submits that there is at least inherent support within the specification as filed for this amendment. Lines 15-20 on page 5 discuss how the information for establishing the link can be provided (without user input), such as “during installation of the printer driver,” “when printer 104 . . . indicat[es] that printer 104 is available,” and so on. Furthermore, lines 5-16 on page 9 discuss how “a representative print dialog box 500 is displayed that includes various information about the printer,” including “a link [being] displayed” (without user input) “in status information field 520” (automatically). Thus, the user does not have to actually input the link; that is, the link is previously established, and when in response to user input the dialog box is displayed, the link is automatically displayed within the dialog box as part of the dialog box being displayed.

Applicant notes that the MPEP states that “[t]he subject matter of [a] claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” (MPEP sec 2163.02) The MPEP further notes that

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing *explicit* concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

(MPEP sec. 2163.07(a) (citations omitted) (emphasis added)) Thus, insofar as it may not explicitly be stated that the link is displayed within the dialog box without the user having to input the link, such that the link is automatically displayed within the dialog box as part of the dialog box being displayed, this is what is inherent in the patent application as filed. Therefore, Applicant is permitted to amend the claims to recite this aspect of the disclosure.

Matsubayashi does not disclose this aspect of the claimed invention added to the independent claims. In contradistinction to the claimed invention, Matsubayashi displays the link within its window *with* the user having to input the link. In contradistinction to the claimed invention, Matsubayashi does not *automatically* display the link within its window as part of this window being displayed. Therefore, Matsubayashi does not anticipate the claimed invention for at least this reason.

Displaying a link within a dialog box

The claimed invention is limited to a dialog box being displayed, where the dialog box includes the link, and where the link is displayed within the dialog box. The Examiner has indicated that Matsubayashi discloses this aspect of the claimed invention insofar as a web page/window is displayed, and a link is displayed within this web page/window. For instance, the Examiner indicates on page 2 of the office action that Matsubayashi discloses displaying a dialog box as “printer web page 55” in FIG. 6, as described on column 5, line 61.

However, Applicant submits that a web page/window is not the same as a dialog box, such that Matsubayashi does not disclose the *identical* invention that is claimed. A dialog box is a special type of window and is not the same as a window in which a web page is displayed. “All [dialog] boxes are windows, however not all windows are [dialog] boxes.” (See Velocity

Reviews discussion of what a dialog box is vis-à-vis a window, provided in the cofiled IDS.) Examples of non-dialog box windows include web browser windows. (See *id.*) The difference between a dialog box and a “normal” window like a web browser window is that “when a dialog box pops up, the user cannot focus on the original [window] until the box is terminated”; i.e., “a dialog box is always focused.” (See “Working with windows” referenced provided in the cofiled IDS.)

Applicant notes that one of ordinary skill within the art uses the ordinary meaning of terms in the claims unless the specification provides a contrary definition. *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999) (“[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning.”) Likewise, claim language is normally accorded its ordinary and accustomed meaning to those of ordinary skill within the art. (*Renishaw PLC v. Marpos Societa per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998); *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996))

Thus, in the present situation, the meaning to be accorded to the terminology “dialog box” is that which one of ordinary skill within the art ordinarily and normally associates with this phrase. As discussed above, a web page that is displayed within a browser window is not a dialog box. A dialog box is a window, but the converse is not always true. For example, when a dialog box is displayed, a user cannot focus the original window that caused the dialog box to be displayed until the dialog box has been closed. By comparison, an initiating window that causes a browser window to be displayed, in which a web page is displayed within the browser window, can still receive focus even before the browser window is closed.

Applicant asks that the Examiner try this simple experiment to see the difference between a normal window, like a web browser window as in *Matsubayashi*, and a dialog box, as in the claimed invention. First, in the window for Microsoft Word or another type of word processing

program, from the file menu, select the print command. This causes a dialog box to be displayed. Now, note that you cannot revert control (i.e., focus) back to the original window while the dialog box is displayed. Rather, you first have to close the dialog box before control/focus reverts back to the original window. This shows the behavior of a dialog box, as in the claimed invention.

Now, second, in the window for Microsoft Outlook or another type of email program, access an email that has a link to a web page, and click (i.e., select) the link. This will cause a browser window to be displayed, such as a browser window for Internet Explorer or another type of web browsing program, in which the web page in question is displayed. However, even before you close this web page window, you can still cause the original email program window to receive focus and have control – to view other emails, and so on. That is, unlike a dialog box, the web browser window does not prevent the original (email program) window that resulted in the web browser window being displayed from still having control. You can have both the web browser window and the original (email program) window open, and can revert control between these two windows as desired. This shows the behavior of a normal window, like a web browser window, as in Matsubayashi.

Therefore, interpreting the claim language as required by case law – where terms are to be accorded their customary and ordinary meaning to those of ordinary skill within the art – means that the claim language of the invention is not disclosed by Matsubayashi. (Applicant notes that this interpretation is consistent with how the USPTO typically interprets claims, where claim language is afforded its broadest *reasonable* meaning to *those of ordinary skill within the art*. Here, the broadest reasonable meaning to those of ordinary skill within the art corresponds to the customary and ordinary meaning to those of ordinary skill within the art.) Matsubayashi in particular discloses displaying a normal window, especially a web browser window, and does not disclose displaying a dialog box, as in the claimed invention. For these reasons as well, then, Matsubayashi does not anticipate the claimed invention.

Claim rejections under 35 USC 103

Claim 4 has been rejected under 35 USC 103(a) as being unpatentable over Matsubayashi in view of Wiley (2004/0137855). Claim 5 has been rejected under 35 USC 103(a) as being unpatentable over Matsubayashi in view of Wiley and further in view of Nishimura (2004/0085563). Claim 6 has been rejected under 35 USC 103(a) as being unpatentable over Matsubayashi in view of Wiley and Nishimura, and further in view of Wu (2004/0130746). Claim 7 has been rejected under 35 USC 103(a) as being unpatentable over Matsubayashi in view of Lin (6,757,070). Claims 8, 12, and 15 have been rejected under 35 USC 103(a) as being unpatentable over Matsubayashi in view of Wu.

Claims 4-8, 12, and 15 are dependent claims, depending ultimately from one of the independent claims discussed above. Therefore, these claims are patentable at least because they depend from patentable base independent claims.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicant's representative, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Date

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